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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,972	08/29/2001	Yoshihide Murakami	213338	7743
23460	7590	12/04/2003	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	16

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,972

16016  
Applicant(s)

MURAKAMI ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/03;4/30/03;6/5/03;9/5/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

1. In view of the newly discovered prior art, PROSECUTION IS HEREBY REOPENED. A rejection based on said prior art is deemed proper and is set forth below. An apology is extended to applicants for any inconvenience that this may have caused.

**Information Disclosure Statement**

2. The information disclosure statement filed 06/05/03 has been considered and placed in the application file. The prior art to Otsuka et al (U.S. 4,608,249) cited by applicants and listed on a FORM PTO 1449 is noted with interest in teaching a drug-containing patching layer comprising an acrylic copolymer of 5 to 75 weight % of an (meth)acrylic ester having an ether group in the molecule, 85 to 15 weight % of an alkyl (meth)acrylate and 10 to 50 weight % of a polar monomer, said prior art considered merely cumulative to the prior art infra.

**Claim Rejections - 35 USC § 102**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-16 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Muraoka et al(U.S. 5,876,745) or Muraoka et al(U.S. 6,139,867).

As to claims 1-16, Muraoka et al'745 and Muraoka et al'867 teach(1 & 9) an adhesive composition for application to skin, which comprises an acrylic copolymer (100 parts by weight) obtained from a monomer mixture comprising a (meth)acrylic acid alkyl ester monomer (40-80 wt %), an alkoxy group-containing ethylenically unsaturated monomer (10-60 wt %) and a carboxy group-containing ethylenically unsaturated monomer (1-10 wt %), col. 2, lines 42-67, col. 3, lines 1-67 and col. 4, lines 1-6 of Muraoka'745 and col. 2, lines 37-67, col. 3, lines 1-67 and the claims of Muraoka et al'867 and a carboxylic acid ester (20-120 parts by weight), which is liquid or paste at room temperature(col. 4, lines 7-55 of Muraoka'745 and col. 4, lines 1-50 and the claims of Muraoka'867;(2 & 10) wherein the carboxylic acid ester is a glycerine ester of saturated fatty acid(col. 4, line 40 of Muraoka'745 and col. 4, line 36 and the claims of Muraoka'867);(3 and 11) wherein the saturated fatty acid has 8 to 10 carbon atoms(col. 4, lines 41-54 of Muraoka'745 and col. 4, lines 36-50 and the claims of Muraoka'867);(4 & 12) wherein, the saturated fatty acid having 8 to 10 carbon atoms is selected from the group consisting of a caprylic acid, a capric acid and a 2-ethylhexanoic acid(col. 4, lines 52-55 of Muraoka'745 and col. 4, lines 47-50 of Muraoka'867);(5 & 13) wherein, the glycerine ester is a triglycerine ester(col. 4, line 41 of Muraoka'745 and col. 4, line 36 of Muraoka'867);(6 & 14) wherein, the glycerine ester of saturated fatty acid is selected from the group consisting of triglyceryl caprylate, triglyceryl caprate and triglyceryl 2-ethylhexanoate(col. 4, lines 41 & 52-55 of Muraoka'745 and col. 4, lines 36 & 47-50 of Muraoka'867); (7 & 15) wherein, the adhesive composition is chemically crosslinked(col. 5, lines 1-29 of Muraoka'745 & the paragraph bridging cols. 4-5 of Muraoka'867); (8 & 16) wherein, the chemical crosslinking is performed using an organic compound selected from the group consisting of an organic peroxide, an isocyanate compound, an epoxy compound and a metal chelate compound(col. 5, lines 1-29 of Muraoka'745 & the paragraph bridging cols. 4-5 of

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Muraoka'867). Each of Muraoka'745 and Muraoka'867 therefore anticipate the instantly claimed invention(see in particular Run 1). While patentees are silent relative to the gel fraction of the disclosed acrylic copolymers(see claims 1 & 9), it is tenable that this limitation may be met by the acrylic copolymers of each of Muraoka'745 and Muraoka'867 since the acrylic copolymer of each of patentees is essentially the same as and made in essentially the same manner as the claimed acrylic copolymer and in the absence of the USPTO to have at its disposal the tools nor facilities to make physical determinations of this sort. The onus to show that the acrylic copolymers of patentees do not possess the claimed gel fraction is shifted to applicants under the guise of *In re Fitzgerald*(619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980)) or *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34(CCPA 1977)).

#### Conclusion

5. The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

#### Response to Arguments

6. Appellants' arguments, see paper no. 15, filed 09/05/03, with respect to the rejection(s) of claim(s) 1-16 under 35 USC 102(b) over Shirai et al(U.S. 5,543,151) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Muraoka et al(U.S. 5,876,745 & 6,139,867) and is as set forth supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
11.30.03